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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/914,790  | 12/19/2001  | Bernhardt Dilz       | 225/50372           | 4260             |
| 7590  | 01/05/2004  |                      | EXAMINER            |                  |
| Crowell & Moring<br>PO Box 14300<br>Washington, DC 20044-4300 |             |                      | HENDERSON, MARK T   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3722                |                  |
| DATE MAILED: 01/05/2004                                       |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/914,790

Applicant(s)

DILZ ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-32 is/are allowed.
- 6) ☒ Claim(s) 14-23 and 33-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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1. Claims 14-21, 23, 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Gosselin et al (5,885,677).

Gosselin discloses in Fig. 1 and 2, a security film comprising a carrier layer (26) containing an identification medium (32), wherein the identification medium is variedly diffused (through intermittent spacing of the barrier layer) from the security film to a substrate (30, in Fig. 2); a barrier layer (24) arranged between the carrier layer (26) and the substrate (30) and which, in an uninscribed state prevents diffusion (however, not fully, as disclosed in Col. 5, lines 35-43) of the identification medium from the film to the substrate; wherein the identification medium comprises at least one from the group consisting of UV-fluorescent marker substance, infrared marker substance, magnetic marker substance, and a dye (Col. 5, lines 6-10); wherein the identification medium consist of a substance that causes a chemical reaction in the substrate to etch a surface of the substrate (Col. 2, lines 5-8); wherein the security film is arranged on a release paper (28); and wherein the security film can be placed on a Vehicle Identification Number label, which is then placed on vehicle paint (Col. 6, lines 25-55).

In regards to **Claims 14-17**, local variation in the diffusion by weakening the barrier layer through an inscription process achieved by: electromagnetic radiation; heat; or a laser beam does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious form a product of the prior art, the claim is unpatentable even though the prior art was made by a

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different process (see MPEP 2113). Therefore, it would be obvious to incorporate intermittent spacing of the barrier layer to allow the diffusion of the identification in preselected areas.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al in view of Pennance et al (EP-845,767).

Gosselin et al discloses a security film comprising all the elements as claimed in Claim 14, and as set forth above. However, Gosselin et al does not disclose wherein the security film has a laser-inscribable covering layer.

Pennance et al discloses a security film (10) having a laser inscribable covering layer (14).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gosselin et al's security film with a laser-inscribable covering

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layer as taught by Pennance et al for the purpose of imparting permanent indicia on the film for prevention of tampering.

*Allowable Subject Matter*

3. Claims 24-32 are allowed.

4. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a method of inscribing a security film that is adhesively bonded to a substrate; wherein the method comprises bonding a security film to a substrate, wherein the film comprises a carrier layer containing an identification medium and a barrier layer arranged between the carrier layer and the substrate; inscribing the security film by a contactless process to weaken the barrier layer and allow selective diffusion of the identification medium from the film to the substrate; wherein the diffusion properties of the identification medium are changed.

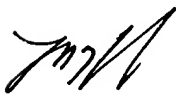
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***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Kulper et al, Reiter et al, Koops et al, Koops et al ('068), Holt et al, Curatolo, Fossum et al, Haas et al, Etheredge, and Jack disclose similar films.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 24, 2003



Daniel W. Howell  
Primary Examiner  
Art Unit 3722